

REMARKS

Reconsideration of the above-identified application in view of the amendment above and the remarks below is respectfully requested.

Claims 6-19 and 21-22 have been canceled in this paper without prejudice or disclaimer of the subject matter thereof. Claims 1 and 4 have been amended in this paper. New claims 24-35 have been added in this paper. Therefore, claims 1-4 and 24-35 are pending and under active consideration.

The specification stands objected to “because the following sections (Background of the Invention, Brief Summary of Invention, etc.) of the specification are missing. Furthermore, the ‘Brief Description of the Several Views of the Drawing’ portion should include a brief description of Figs 9 and 10.”

In response, Applicant notes that the provision of section headings in the specification is not a statutory or regulatory requirement, but rather, is merely a suggested guideline. Nevertheless, Applicant has amended the specification to include several section headings. In addition, Applicant has amended the specification to include a brief description of Figs. 9 and 10. Accordingly, the objection to the specification has been overcome and should be withdrawn.

Claims 1-4, 6-19 and 21-22 stand rejected under 35 U.S.C. 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In support of the rejection, the Patent Office states the following:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Applicant is respectfully reminded that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation “few optical reflections”, and the claim also recites “preferably no optical reflections” which is the narrower statement of the range/limitation.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the means to provide the chamber with no optical reflections. How is this accomplished?

Claim 4 recites the image-recording device is aligned with and focused on the container at an acute angle. It is not clear which axis (vertical, horizontal) the angle is determined.

Claim 7 recites “in each case on both sides of the container located in the analysis position is a lateral lamp...”. What sides? Does applicant mean top side, bottom side, lateral sides, etc?

Applicant respectfully traverses the subject rejection. Insofar as the rejection is predicated on the presence of both broad and narrow limitations within claim 1, Applicant has amended claim 1 to overcome this ground. Insofar as the rejection is predicated on an alleged omission of essential elements in claim 3, Applicant respectfully traverses the rejection. The Patent Office is apparently taking the position that claim 3 must recite **how** the chamber is provided with no optical reflections.

In response, Applicant respectfully submits that such information need not be presented in a claim. Applicant notes that the specification discloses, for example, at page 7, lines 7-15, that the chamber having no optical reflections may be provided with inner walls having matte black surfaces. There is no reason why this type of information needs to be recited in a claim. A person of ordinary skill in the art, after having read the present specification, would understand what is meant by the language of claim 3. This is all that is necessary to comply with the definiteness requirement of 35 U.S.C. 112, second paragraph.

Insofar as the rejection is predicated on an alleged lack of clarity in claim 4 as to which axis (horizontal or vertical) the angle is determined, Applicant respectfully disagrees. Claim 4 recites “in its vertical alignment.” Insofar as the rejection is predicated on a recitation of “both sides” in claim 7, Applicant notes that claim 7 has been canceled in this paper. Nevertheless, similar language appears in amended claim 1 (albeit with “both sides” of claim 7 being changed to “two sides” in claim 1). With respect to amended claim 1, Applicant respectfully submits that the sides do not need to be specified for the claim to be definite.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-3, 6, 13-14, 19 and 21-22 stand rejected under 35 U.S.C. 102(b) “as being anticipated by Watson et al. (WO 99/28724), hereinafter Watson.” In support of the rejection, the Patent Office states the following:

Watson teaches an arrangement for analyzing body fluids having an image-recording device 22 (color image digital camera) connected to an electronic image evaluation apparatus (controller, not shown) and a barcode scanner 20. The body fluid is provided in container 14 inside a chamber 10 believed to have few optical reflections provided by the bias in the variation in brightness of the illumination means 142. In the analysis position, the image recording device is aligned with and focused on the container, and an

illuminating device 142 for illuminating the container from above and below. The Watson arrangement also includes a pair of grippers 146 capable of holding the tube by a predetermined angle so that the camera can capture images of the sample through a portion or window of the tube not obscured by the label 88. The image-processing methodology of claims 21-22 is taught at page 21, line 3+ of Watson.

Insofar as the subject rejection relates to claims 6, 13-14, 19 and 21-22, the rejection is moot in view of Applicant's cancellation herein of claims 6, 13-14, 19 and 21-22. Insofar as the subject rejection relates to claims 1-3, Applicant respectfully traverses the rejection.

Claim 1, from which claims 2-3 depend, has been amended herein and now recites "[a]n arrangement for analyzing body fluids wherein an image recording device is provided and is connected to an electronic image evaluation apparatus, wherein the body fluid is provided in a chamber; with few optical reflections, said chamber being in a container, the image recording device being aligned with and focused on the container, which is in an analysis position, an illuminating device being arranged above the container, wherein on each of two sides of the container located in the analysis position a lateral lamp is arranged, the arrangement being such that the mid points of the two lamps and the mid point of the container lie on a straight line (A), a further, middle lamp being provided and arranged in such a way that the mid points of this middle lamp and of the container likewise lie on a straight line (B), which runs perpendicular to the straight line (A)."

Claim 1 is neither anticipated by nor rendered obvious over Watson for at least the reason that Watson does not teach or suggest an arrangement comprising, amongst other things, the claimed combination of lateral lamps. The Patent Office concedes that Watson fails to teach or to suggest the claimed combination of lateral lamps since, in connection with canceled claim 7, which

recites similar language, the Patent Office acknowledges that this teaching is missing from Watson and then relies on Chandler as allegedly providing this missing teaching. However, Applicant respectfully submits that one of ordinary skill in the art would have had no reason to modify the apparatus of Watson along lines of Chandler. This is, in part, because the image analyzing apparatus of Watson is used only to identify the type of cap in a test tube. Given the limited purpose of the Watson image analyzing apparatus, there would have been no reason to replace the Watson image analyzing apparatus with the more complicated arrangement of Chandler.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 4 and 7-12 stand rejected under 35 U.S.C. 103(a) “as being unpatentable over Watson (WO 99/28724) in view of Chandler (US Patent No. 6,139,800).” In support of the rejection, the Patent Office states the following:

The teachings of Watson have [been] summarized previously, *supra*. Watson does not teach a lateral lamp arranged on both sides of the container. The arrangement being such that the mid points of the two lamps and the mid point of the container lie on a straight line (A), and a middle lamp is provided and arranged in such a way that the mid points of this middle lamp and the container lie on a straight line (B). Line B runs perpendicular to the line (A).

Chandler teaches an apparatus for use in assays. The apparatus includes a lateral lamp 12, 16 arranged on both sides of a container 1 (see Fig. 4). The arrangement being such that the mid-points of the two lamps and the mid-point of the container lie on a straight line (A). See figure 4 of Chandler. Furthermore, a middle lamp 14 is provided and arranged in such a way that the mid points of this middle lamp and of the container, likewise, lie on a straight line (B), which runs perpendicular to the line (A).

With respect to claim 8, Chandler teaches the optical axis of the image recording device 10 runs in a vertical plane that is perpendicular to the line (A). The line (B) lines in this vertical plane, see Fig. 4. Please note that Chandler teaches that while laser diodes are preferred, other optical sources/detectors are suitable.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have included in Watson, the specific optical and detector configuration taught in Chandler in order to provide a multitude of excitation wavelengths at no significant and/or measurable cost to measurement accuracy.

Regarding the specific spacing of each lamp from the container being sixty millimeters (claim 10) and the difference in height between the lateral lamps and middle lamp is sixteen millimeters. It would have been an obvious matter of design choice to make the spacing between each lamp from the container sixty millimeters and the difference in height between the lateral lamps and the middle lamp sixteen millimeters, in the combined system of Watson and Chandler, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Insofar as the subject rejection relates to claim 4, Applicant respectfully traverses the subject rejection. Claim 4 depends from claim 1. Claim 1 is patentable over Watson in view of Chandler for at least the reasons discussed above. Therefore, based at least on its dependency from claim 1, claim 4 is patentable over Watson in view of Chandler.

Insofar as the subject rejection relates to claims 7-12, the rejection is moot in view of Applicant's cancellation herein of these claims. However, new claims 24-28 correspond to canceled claims 8-12 are patentable based at least on their respective dependencies from claim 1.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 15-18 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Watson (WO 99/28724) in view of Toshiaki (JP 09-133687)." In support of the rejection, the Patent Office states the following:

The teachings of Watson have [been] summarized previously, *supra*. Watson does not recite an anti-reflection plate arranged on

the side of the container and turned away from the image recording device.

Toshiaki does teach an anti-reflection plate (plastic body or piece of paper) made of a white or gray material placed behind the tube when the image is recorded, in order for the background to be as uniform as possible and arranged on the side of the container, turned away from the image recording device, see paragraph [0042] of Detailed Description section of Toshiaki (see attached translation). The flexible paper is believed capable of creating a concave depression adapted to conform to the peripheral shape of the container. It is obvious to a person skilled in the art that is measure is most effective if the material is in direct contact with the label, not only along a line of contact but over entire rounded surface of the container. Furthermore, it would have been obvious to the skilled artisan that the material not have a visually disruptive, abrupt structure, even in places where it is not lying flat. Thus, one would have inevitably caused a skilled person in the art to round the edges, as set forth in claim 17.

With respect to claim 18, the anti-reflection material is arranged such that it “can be” moved away from the container by a person. Note that the method of using holds no patentable weight in an apparatus claim. Only structural language is determinative of the metes and bounds of a patent apparatus claim. Functional recitations, standing alone, while perhaps helpful in understanding the meaning of a claim and the invention that it represents, cannot be relied upon to distinguish over the prior art. Nevertheless, functional language in the claims must be given full weight and many not be disregarded in evaluating the patentability of the subject matter defined employing such functional language. However, an applicant must establish that what is expressly taught by the prior art does not inherently function in the manner required by the claim.

Furthermore, with respect [to] claim 18, it has been held that the recitation that an element “can” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have included in Watson, the specific optical and detector configuration taught in Toshiaki in order to provide an anti-reflection plate to make the

exterior of the tube as uniform as possible to remove the background noise resulting from a tube with or without label.

Insofar as the subject rejection relates to claims 15-18, the rejection is moot in view of Applicant's cancellation herein of claims 15-18.

However, Applicant notes that new claims 31-33 recite an antireflection plate. Consequently, the comments below are directed to new claims 31-33. New claims 31-33 depend from claim 1. Claim 1 is patentable over Watson for at least the reasons given above. Toshiaki (as well as Chandler, as discussed above) fails to cure all of the deficiencies of Watson with respect to claim 1. Therefore, based at least on their respective dependencies from claim 1, claims 31-33 are patentable over the applied combination of references.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 21-22 stand provisionally rejected "on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 7 of copending Application No. 10/502,137." In support of the provisional rejection, the Patent Office states the following:

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method for analyzing body fluids characterized in that an image recording device is used to produce at least one image of the body fluid location in a container that is analyzed by means of image processing software.

In response, Applicant notes that claims 21-22 have been canceled in this paper. Therefore, the subject provisional rejection is moot and should be withdrawn.

New claims 24-35 have been added in this paper and do not constitute new matter. New claims 24-35 depend from claim 1 and are patentable for at least the same reasons as claim 1.

It is respectfully submitted that the present application is now in condition for allowance.

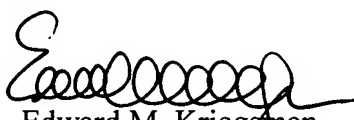
Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Kriegsman & Kriegsman

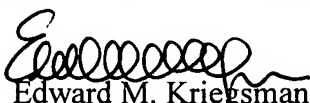
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on *January 7, 2008*


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